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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,828	11/12/2003	Joseph P. Bigus	YOR920030510US1	8826

7590 08/14/2007
Moser, Patterson & Sheridan
Suite 100
595 Shrewsbury Avenue
Shrewsbury, NJ 07702

EXAMINER

CHEN, QING

ART UNIT	PAPER NUMBER
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2191

MAIL DATE	DELIVERY MODE
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08/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/712,828	Applicant(s) BIGUS, JOSEPH P.	
	Examiner Qing Chen	Art Unit 2191	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

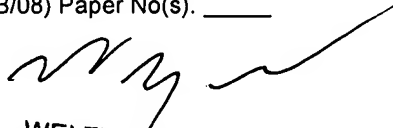
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,2,4-15,17-27 and 29-31.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


 SUPERVISOR
 WEI ZHEN
 CHIEF EXAMINER

Continuation of 3. NOTE: Applicant's arguments are not persuasive.

In the remarks, Applicant argues that:

Claims 26-27 and 29-31 recite computer-readable media for storing software Instructions for customizing a rule-based application. As the Supreme Court has recognized, Congress chose the expansive language of 35 USC §101 so as to include "anything under the sun that is made by man" as statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980) (MPEP 2106, emphasis added). The Applicants respectfully submit that computer-readable media, including acoustic or light waves carrying instructions that are readable by a processor, are made by man and are not naturally occurring phenomena.

The Examiner nevertheless submits that "the phrase 'anything under the sun that is made by man' is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process" (emphasis added). The Applicants submit that a computer-readable medium, including acoustic or light waves carrying instructions that are readable by a processor, qualifies as a "manufacture" under the provisions of 35 U.S.C. §101, which allows for a broad interpretation of the term "manufacture" (See, e.g., MPEP 2105). For instance, the Court in *Chakrabarty* found that "in choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope". The Court further found that a "nonnaturally occurring manufacture or composition of matter - a product of human ingenuity - having a distinctive name, character, [and] use" is patentable subject matter (emphasis added). As discussed above, computer readable media - even including acoustic or light waves - that carries instructions readable by a processor is not a naturally occurring phenomena, but rather owes existence to human ingenuity and intervention that bestows "new forms, qualities, properties, or combinations".

Examiner's response:

Examiner disagrees with Applicant's assertion that computer-readable media, including acoustic or light waves carrying instructions that are readable by a processor, are made by man and are not naturally occurring phenomena. As previously pointed out in the Final Rejection (mailed on 05/31/2007) and currently maintained by the Examiner, the 35 U.S.C. § 101 rejections of Claims 26, 27, and 29-31 are consistent with the Office's current policies regarding non-statutory subject matter. Such signal claims are ineligible for patent protection because they do not fall within any of the four statutory categories of § 101 (process, machine, manufacture, or composition of matter). The recited processor of the claim only serves as an intended use limitation rather than a hardware component to qualify it as a product of manufacture.

In the remarks, Applicant argues that:

By contrast, the cited portions of *Grindrod* at most teach that a user (e.g., an administrator) can build expressions or conditions for business logic rules by entering variables into a user interface that has been dictated to the user. In other words, *Grindrod* teaches a method for completing a predefined "template" having predefined fields that are modifiable by a user (i.e., the user interface tells the user what is "customizable"). Nowhere in *Grindrod* is a method taught in which the user interface - or a template - itself is created by designating which elements of a set will be customizable by a user (e.g., such that the user can decide what is customizable).

Examiner's response:

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., a user can decide what is customizable) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).